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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/601,144 | 06/20/2003 | Raghubir S. Bhullar | WP 19085 US2 | 3263 |
| 32842 | 7590 | 11/16/2005 | EXAMINER | |
| THE LAW OFFICE OF JILL L. WOODBURN, L.L.C. JILL L. WOODBURN 128 SHORE DR. OGDEN DUNES, IN 46368 | | | ARBES, CARL J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3729 | |

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,144

Applicant(s)

BHULLAR ET AL.

Examiner

C. J. Arbes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 49-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 49-75 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 9-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date herein.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Applicants' REMARKS filed on or about 15 September 2005 have been carefully considered and are found to be persuasive only to the extent that Groups I and III inventions are not independent nor distinct. Group II however continues to be held to be independent and distinct from Group I and III and is tacitly admitted by Applicants to be so independent and distinct. In view of the cancellation of all Group II claims and the Patent Office's change of position with respect to the Group I and Group III invention it is moot to require cancellation of said Group II claims.

An Office Action on the merits of Claims 1-20 and 49-75 follows.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wadman et al (WO 95/22881), of Record; hereinafter Wadman et al

Wadman et al teach a method of furnishing a substrate with a patterned film of electrode using a laser. An electrode material e.g. metals or metal oxides (which include In and Sn oxides (Cf. Col 4) overlie an assistant metal which is placed on a substrate. (Cf. Abstract). A laser beam is directed to the layers so that the electrode layer is caused to detach. It is clear from at least Figure 7 that there are at least 2 electrode patterns which have different sizes e.g. different widths. The assistant material (which is directly beneath the electrode material) can be polyacrylate (Cf. Col 4). The limitations recited in e.g. claims 4-6 and 18-20 are held to be limitations which

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would clearly be within the ordinary skill of an artisan and hence is not patentable subject matter. Moreover what does the fact that the electrode pattern is formed in less than 0.25 seconds (Claim 18), in less than 50 nanoseconds (Claim 19) or less than 25 nanoseconds (Claim 20) have to do with a method of making a biosensor. Isn't these limitations a function of the laser or laser beam which is used? As applied to claims 4-6 it is held that these limitations are within the ordinary skill of an artisan and that no patentable weight should be accorded thereto. As applied to claims 7 and 16 it is quite apparent that these limitations have little or nothing to do with the ...a method for making a biosensor... and hence these limitations are accorded little or no patentable weight. Don't these limitations have to do with the design or features of the laser which is used to construct or define the electrode pattern? As applied to claim 8 it is held that it would have been obvious to construct an electrode pattern which has an interlacing pattern since this type of pattern would provide the optimum results i.e. use less real estate or area and obtain optimum results i.e. be more cost effective.

Claims 9-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 49-75 are held to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. J. Arbes whose telephone number is 571-272-4563. The examiner can normally be reached on M, T, R and F from 8 to 6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Vo, can be reached on 571-272-4563. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. J. Arbes
Primary Examiner
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